

REMARKS

Upon entry of the present amendment, claims 1-28 will be pending. Claim 19 has been withdrawn. The abstract has been replaced with a new abstract. Claims 1, 16, 17, and 20 have been amended merely to correct formalities. Applicants submit that no new matter has been added.

Objections to the Abstract

The Examiner objected to the abstract and suggested that Applicants "amend the abstract so that it corresponds to at least one independent claim" (at page 2). The abstract has been amended accordingly. Withdrawal of all objections to the abstract is respectfully requested.

Information Disclosure Statement

The Examiner enclosed a return-copy of the Form PTO-1449, showing Examiner's initials by the considered references. Applicants note that the references listed under "U.S. Patent Documents" section include initials next to only two of the ten listed references. Applicants respectfully request that the Examiner forward them a copy with all references initialed.

Rejections under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 1-18 as allegedly being indefinite (at page 3). According to the Examiner,

[c]laim 1, and all claims dependent therefrom, are indefinite for reciting the phrase "in the presence of the target thereby forming replicate phage-immobilized target complexes," because it appears that the product of forming replicate phage in the presence of a target forms a phage-target complex, not a phage-immobilized target complex. Applicants have not made it clear that the target in this step has been immobilized (at page 3).

Without conceding to the substance of the rejection, Applicants amended step (e) of claim 1 to clarify that the target is immobilized to the support.

Further, the Examiner stated that:

[c]laim 1, and all claims dependent therefrom, are indefinite for reciting the term “diverse” because one of ordinary skill in the art cannot reasonably determine which library member would be considered diverse and those that are not. The term is not used as an art-accepted term with a definite meaning, and is not defined in the specification.

Applicants traverse. As the specification states, “[i]n one aspect, the invention provides a variety of accelerated methods for identifying members having a desired binding property from display libraries, e.g., phage display libraries” (at page 15, first sentence of the Detailed Description). It is well-known in the art that display libraries include diverse members. The specification provides a discussion of display libraries that “are diverse collections of proteins,” for example “[p]hage display uses bacteriophage particles as vehicles for linking a diversified protein to the nucleic acid” (at page 1, first and second paragraphs of the Background, emphases added). Applicants submit that a skilled practitioner would be able to determine whether a plurality of phage members are diverse, based on the maturity of display libraries field at the time of filing the application.

Moreover, according to the Examiner, “[c]laims 15 and 16 are indefinite for reciting the phrase ‘producing e)’ because it appears that claim text has been omitted and the claim is unclear” (at page 3). Applicants note that the phrase “producing e)” is recited in claims 16 and 17 (rather than claims 15 and 16), which have been amended to recite the elements of step e) of claim 1.

The Examiner rejected claim 20 and all claims dependent from it because they “recite the limitation ‘each input phage’ in step (d)(1). There is insufficient antecedent basis for this limitation in the claim” (at page 3). Without conceding the argument, Applicants amended step (d)(1) of claim 20 to clarify that the recited phage refers to the phage member selected in step (b) of claim 20.

Withdrawal of all indefiniteness rejections is respectfully requested.

Rejections under 35 U.S.C. § 102(a)

The Examiner rejected claims 1-7, 9-15, 20-24, and 26-28 as allegedly being anticipated by Al-bukhari *et al.*, *J. Immunol. Meth.* 264:163-71, 2002 ("Al-bukhari") (at page 4). Without conceding to the substance of the rejection, Applicants submit herewith as Exhibit A, a Declaration under 37 C.F.R. § 1.131 ("Declaration"), showing that the claimed methods were reduced to practice before June 21, 2002, when Al-bukhari became public. Exhibits B-D provide supporting documentation for the Declaration. As stated in the Declaration, Applicants reduced the claimed methods to practice prior to the publication of Al-bukhari. Therefore, Al-bukhari is not available as prior art against the present claims.

Withdrawal of all anticipation rejections is respectfully requested.

Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-7, 9-15, and 20-28 as allegedly being obvious over Al-bukhari in view of Srivastava (U.S. Pat. No. 6,797,480) (at page 6). As discussed above, because Al-bukhari is removed as a prior art reference based on the Declaration, it cannot be cited in an obviousness rejection.

The Examiner rejected claims 1-7, 9-15, 18, 20-24, and 26-28 as allegedly being obvious over Al-bukhari in view of Wittrup *et al.* (U.S. Pat. No. 6,423,538) (at page 7). As discussed above, because Al-bukhari is removed as a prior art reference, it cannot be cited in an obviousness rejection.

Withdrawal of all obviousness rejections is respectfully requested.

Conclusion

Applicants respectfully submit that all claims are in condition for allowance, which action is expeditiously requested. Applicants do not concede any positions of the Examiner that are not expressly addressed above, nor do Applicants concede that there are not other good reasons for patentability of the presented claims or other claims. All amendments and withdrawals are made without prejudice and disclaimer and may be made for reasons not explicitly stated or for reasons in addition to ones stated.

Enclosed is a Petition for Three-Month Extension of Time and a \$510.00 check for the required fee. Please apply any other charges or credits to deposit account 06-1050, referencing Attorney's Docket Number 10280-053001.

Respectfully submitted,

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